

**REMARKS**

Claims 208, 210, 213, 214, 221-225, 228-231, and 233-240 are pending and under examination in the subject application. By this Amendment, applicants have amended claims 208, 213, 224, and 231. Accordingly, upon entry of this Amendment, claims 208, 210, 213, 214, 221-225, 228-231, and 233-240, as amended, will be pending and under examination.

Applicants have amended the specification to include material previously incorporated by reference. Page 1, lines 17-25, of the specification, as originally-filed, states:

Throughout this application, various references are referred to within parentheses. Disclosures of these publications in their entireties are hereby incorporated by reference into this application to more fully describe the state of the art to which this invention pertains. Full bibliographic citation for these references may be found at the end of this application, preceding the sequence listing and the claims.

At page 4, lines 20-33, the GABA<sub>B</sub>R1a and GABA<sub>B</sub>R1b polypeptides are discussed and a citation to the Kaupmann, et al. 1997 paper is provided in parenthesis. The full citation for the Kaupmann, et al. paper is set forth on page 131, lines 6-11 of the specification, as originally-filed.

M.P.E.P. Section 608.01(p) states:

The filing date of any application wherein essential material is improperly incorporated by reference to a foreign application or patent or to a publication will not be affected because of the reference. In such a case, the applicant will be required to amend the specification to include the material incorporated by reference. . . . The amendment must be accompanied by

an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. . . .

Applicants have amended the specification to include the amino acid sequences of the GABA<sub>B</sub>R1a and GABA<sub>B</sub>R1b polypeptides disclosed by Kaupmann, et al. as provided for in M.P.E.P. Section 608.01(p). In support of this amendment, applicants attach hereto as **Exhibit 4** a Declaration of Beth E. Borowsky pursuant to 37 C.F.R. §1.132. In her declaration, Dr. Borowsky states that she incorporated by reference a paper by Kaupmann, et al. entitled "Expression cloning of GABA<sub>B</sub> receptors uncovers similarity to metabotropic glutamate receptors", *Nature* (1997) **386**: 239-246 (the "Kaupmann Paper") into the subject application to define the amino acid sequences of the GABA<sub>B</sub>R1a and GABA<sub>B</sub>R1b polypeptides. Dr. Borowsky further states that the amendatory material, namely, the addition of the amino acid sequences of the GABA<sub>B</sub>R1a and GABA<sub>B</sub>R1b polypeptides to the specification of the subject application, consists of the same material which she incorporated by reference into the subject application to define the amino acid sequences of the GABA<sub>B</sub>R1a and GABA<sub>B</sub>R1b polypeptides.

Applicants maintain that the amendments to claims 208, 213, 224, and 231 raise no issue of new matter. Support for the amendments to claims 208, 213, 224, and 231 may be found inter alia in the specification, as amended, on page 26, line 3+; page 43, line 2+; Figure 24A-24D and Figure 25A-25D. Applicants respectfully request that the Amendment be entered.

**Rejection Under 35 U.S.C. 112, First Paragraph**

On page 3 of the October 30, 2000 Final Office Action, the Examiner rejected claims 208, 210, 213, 214, 221-225, 228-231, 234, and 236-240 under 35 U.S.C. §112, first paragraph, as put forth in Paper 12 (item 8). The Examiner acknowledged that the specification is enabling for a method of identifying agonists of the GABA<sub>B</sub>R1/R2 receptor wherein the GABA<sub>B</sub>R1 receptor is either of the splice variants disclosed by Kaupmann, et al., referred to in the specification on page 4, and wherein the GABA<sub>B</sub>R2 receptor is either of the polypeptides disclosed in the instant application as SEQ ID NO: 2, 4, or 47, or a polypeptide having an amino acid sequence identical to that encoded by the plasmid deposited as ATCC Accession No. 209104 or 203515, but alleged that the specification does not reasonably provide enablement for a method of identifying agonists of the GABA<sub>B</sub>R1/R2 receptor wherein the receptor GABA<sub>B</sub>R1/R2 comprises polypeptides other than those recited above.

The Examiner then concluded that it would require undue experimentation on the part of any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

In an attempt to advance the prosecution of the subject application, but without conceding the correctness of the Examiner's position, applicants have amended claims 208, 213, 224, and 231. Amended claims 208, 213, 224, and 231 are directed to a mammalian GABA<sub>B</sub>R1/R2 receptor which comprises a GABA<sub>B</sub>R1 polypeptide and a GABA<sub>B</sub>R2 polypeptide, wherein the GABA<sub>B</sub>R1 polypeptide has an amino acid sequence identical to the amino acid sequence shown in Figures 24A-24D (SEQ ID NO: 48) or Figures 25A-25D (SEQ ID NO: 49), and the GABA<sub>B</sub>R2 polypeptide has an amino

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acid sequence (a) identical to the amino acid sequence shown in Figures 4A-4D (SEQ ID NO: 4) or Figures 23A-23D (SEQ ID NO: 47) or (b) encoded by a nucleic acid sequence identical to the receptor-encoding nucleic acid sequence contained in plasmid pEXJT3T7-hGABAB2 (ATCC Accession No. 203515) or in plasmid BO-55 (ATCC Accession No. 209104). Claims 210, 214, 221-223, 225, 228-230, and 233-240 are all directly or indirectly dependent upon claims 208, 213, 224, and 231.

Applicants maintain that the specification is enabling for the pending claims because the pending claims characterize the GABA<sub>B</sub>R1 receptor and the GABA<sub>B</sub>R2 receptor by reference to an amino acid sequence set forth in a Figure and/or a nucleic acid sequence contained in a plasmid. Applicants note that the Examiner has acknowledged on page 3 of the October 30, 2000 Office Action that claims of this scope are enabled by the instant specification.

In summary, in view of the amendments and remarks made hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the ground of rejection set forth in the October 30, 2000 Final Office Action and earnestly solicit allowance of the claims now pending in the subject application, namely claims 208, 210, 213, 214, 221-225, 228-231, and 233-240.

If the Examiner has any questions regarding this Preliminary Amendment or the accompanying request for continuation prosecution application status, he is cordially invited to telephone the undersigned attorney at the number indicated below.

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No fee, other than the enclosed fee of \$1,186.00 for filing the subject CPA, is deemed necessary. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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John P. White  
Registration No. 28,678  
Attorney for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400